

REMARKS

Reconsideration of this application as amended is respectfully requested. Claim 9 has been amended to include a word that was inadvertently omitted. Claim 36 has been amended for antecedent basis.

Office Action Summary

Claims 1-10, 30-31, 34-37, 39, and 43-51 stand rejected under doctrine of double patenting, as being unpatentable over claims of U.S. Patent No. 6,523,124.

Claims 1, 2, 4-8, 10, 34-39, and 43-51 stand rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent 5,613,135 (“Sakai”) in view of U.S. Patent No. 5,557,738 (“Townslley”) and in view of U.S. Patent No 5,463,742 (“Kobayashi”).

The Office Action indicates Claims 9, 30, 31, 36, 37, and 39 are allowable over the prior art.

Double Patenting Rejections

Applicant requests reconsideration of this rejection for the following reason. U.S. Patent No. 6,523,124 requires in each claim a “signal line” which detects whether “a communication device” is actively coupled. The claims presented with this paper do not use a signal line to detect an active connection to a communication device or other device. Rather, in Claims 4 (as amended), 30, 31, 36 for example, signal line(s) is/are recited for the purpose of determining a type of communication device (not whether the communication device is actively connected).

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4-8, 10, 34-39, and 43-51 stand rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent 5,613,135 (“Sakai”) in view of U.S. Patent No. 5,557,738 (“Townslley”) and in view of U.S. Patent No 5,463,742 (“Kobayashi”).

Applicant requests reconsideration of this rejection for the following reasons. The limitation as recited in claim 1 is not “detecting that an external device is actively connected and providing power” as stated in the Office Action. Rather, the limitation of claim 1 recites:

detecting that an external computing device is actively connected
to communicate and provide power to the portable computing
device

Applicant submits that the Examiner cannot simply modify what is being detected in making an obviousness rejection, as that would be altering the limitation itself. By Examiner’s rationale and admission (Office Action, page 4, lines 16-17), Sakai does not disclose the above recited limitation. Even read in a light most favorable to Examiner’s point of view, Sakai discloses an AC adapter that invalidates a power save mode when connected to a system, or validates a power save mode when disconnected from a system. (Sakai, Column 8, lines 4-16). The external device in Sakai (AC adapter) is not a computing device nor does the AC adapter communicate to a portable computing device.

In addition, Claim 1 recites:

responsive to detecting the external computing device, suspending
execution of at least a portion of a program

The combined references do not teach this limitation. Even if one was to assume a light favorable to Examiner’s interpretation, the combined references lack a teaching of “suspending execution” in response to detecting the external computing device. As mentioned above, the cited references do not teach “detecting the external computing device”, and as such, a resulting response required by this limitation is absent from the cited references.

With regard to Kobayashi, Applicant respectfully disagrees with Examiner’s reliance on the reference. The Office Action states that the laptop in Sakai could be the portable personal processing module (PPM) in the system of Kobayashi. (Office Action, Page 4, line 20 - Page 5, line 2). This statement is not correct. The laptop in Sakai is a device that is fully functional, independent of another device (e.g. docking station of Kobayashi). Kobayashi discloses that the docking station is for a paired device (PPM) that is not independently functional or even operable until it is combined with a docking station. For example, docking station of Kobayashi is to enable use of the PPM, because the PPM does not have its own power supply or battery. The PPM does not even contain human interface input/output devices and/or devices

such as a keyboard, display, or printer. Furthermore, the PPM works after being connected to a docking station that supplies the power supply, fans, input/output devices, display and keyboard for the PPM. (Kobayashi, Column 3 line 49 – Column 4, line 6).

With these differences, Applicant contends that Kobayashi *teaches away* from the claimed invention, and Examiner's efforts to combine the laptop in Sakai with the system of Kobayashi is improper. (See MPEP 2145) Applicant's claims require a portable computing device that is independently operable of an external computing device. Such a portable computing device is in no way comparable to a dependent device (the PPM) that would use the docking station of Kobayashi. As such, Kobayashi actually teaches away from the claimed invention.

Because the laptop of Sakai is fully functional on its own, and does not need a docking station to operate, one skilled in the art would find no purpose in combining it with the docking station of Kobayashi. One uses the docking station of Kobayashi to provide power to a device that has no independent power source, and not to provide power to a device that has a battery, as is the case with Sakai's laptop.

Therefore, because Sakai lacks the above recited limitation of claim 1, and Kobayashi teaches away from the combination of Sakai and Kobayashi, Applicant submits that Sakai and Kobayashi cannot be combined to render claim 1 obvious. Because claims 2-8, 34, 35, and 43 depend from and further limit claim 1, the rationale extends to these dependent claims as well.

Claim 44 recites in part:

causing the external computing device and the portable computing device to communicate with one another in response to a user-interaction with an interface of the external computing device

Applicant reiterates the arguments made above and submits that Sakai does not teach an external computing device other than the portable computing device which provides an interface for receiving user-interaction, let alone enabling this interaction to cause communication to occur between the two computing devices. Because claims 45-51 depend from and further limit claim 44, they are not rendered obvious by the recited combination of references.

With regard to any assumptions made by the Examiner that is based on knowledge outside of the references cited (as such an Official Notice), Applicant makes no admissions to the correctness of the statement, and reserves any right to object to the statement at a later time.

Allowable Subject Matter

Claims 9, 30, 31, 36, 37, and 39 were indicated as being allowable. Furthermore since claim 10 depends from and further limits claim 9, Applicant submits claim 10 is also allowable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. The allowance of the claims is earnestly requested. The Examiner is invited to call the undersigned if there are any issues that remain to be resolved prior to allowance of the claims.

A petition for a two (2) month extension of time is included herewith.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Please charge deposit account 501914 for any underpayments in connection with this Office Action response.

Respectfully submitted,
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